

RECEIVED
CENTRAL FAX CENTER

MAR 10 2006

FAX COVER SHEET

To: USPTO
Art Unit 3636
Exr. Winnie S. Yip

Date: 03/10/06

From: Werner H. Schroeder
Patent Agent # 36,387

Number of pages including cover sheet: 6Comments: response to Office Action Rejection

Werner H. Schroeder
Signature

BEST AVAILABLE COPY

PTO/SB/21 (09-04)

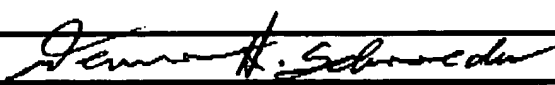
Approved for use through 07/31/2008. OMB 0851-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.


TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/813,946	
	Filing Date	07/07/2003	
	First Named Inventor	Kevin T. Connelly	
	Art Unit	3636	
	Examiner Name	Winnie S. Yip	
Total Number of Pages in This Submission	8	Attorney Docket Number	

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks 1) Amended drawing Sheet 2) Amended claims 3) Arguments		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name			
Signature			
Printed name	Werner H. Schroeder		
Date		Reg. No.	36,387

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	Werner H. Schroeder	Date	03/10/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

BEST AVAILABLE COPY

Response to an Office Action Rejection

Application No. 10/613,946

This communication is a response to an Office Action rejection having a mailing date of 02/22/2006 and setting forth a shortened statutory period for response of three months which would expire on 05/22/2006.

In par. 3 of the examiner's office action, the examiner objects to the drawings because the exploded view in Fig. 1 showing separated parts should be combined by a bracket. This will be done in a substitute drawing sheet.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupferman in view of Bilotti and further in view of Johnson. The examiner is using two references to modify what is being claimed and a third reference is being used to further modify THE first modification. The Board of Appeals, the former CCPA and the now CAFC frown on this tactic to reject claims. It is well settled that the proposed modifications by the examiner must flow from the references and not from applicant's specification.

It is pointed out to the examiner that by the time the various modifications have been made to the Kupferman umbrella, the umbrella cannot perform anymore as was intended. This definitely is not an indicia of obviousness as was promulgated in *Graham v. Deere*.

It is pointed out to the examiner that none of the references cited and used in the rejection of the claims is a combination of a shade cover and a rain cover as is explained in the specification. The rain cover is separate from the shade cover but is of the same size. The rain cover is stored in a separate location until the event of rain occurs. At that instant, the rain cover is placed over the shade cover and is fastened to the shade cover at the tips of the ribs.

BEST AVAILABLE COPY

Again, this is nowhere taught by the three references.

Claim 1 has been amended to clearly set forth the above noted subject of the invention. Therefore, the amended claim 1 and the claims depending therefrom should be clearly allowable over the cited prior art. None of the references teach a separable water proof rain cover which is not in use and stored separably until the event of rain.

Claims 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupferman in view of Bilotti and Johnson and further in view of Allee.

The examiner is now using four references to reject these claims. The applicant is convinced that one of ordinary skill in the art having these four references in front of her/him would not be able to write the claims 9 - 11. That is requirement under 35 U.S.C. 103.

In view of the fact that claim 1 has been amended to clearly set forth applicant's invention, a rejection of these claims should be moot and overcome.

In view of all of the above, it is believed that all rejections and objections have been answered and have been overcome and the examiner is respectfully requested to allow the presently amended claims and pass the application to an early indication of allowance.



Werner H. Schroeder

Reg. No. 36,387

Date: 03/10/06

BEST AVAILABLE COPY